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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,473	03/09/2000	MASAAKI YAMAMOTO	9683/66	8959

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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/508,473

Applicant(s)

YAMAMOTO ET AL.

Examiner

Siegfried E Chencinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 5 & 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Objections*

#### **1. Minor Informalities**

- a. The claims contain at least one spelling error. The examiner found the following:  
Claim 7, line 5, "medating", which apparently should be "mediating". The examiner suggests that applicant run both the claims and the specifications through spell check software to eliminate errors of spellings and grammar. Correction is required.
- b. The examiner objects to the mixed use of the terms "IP" and "information provider" throughout the specifications and claims. It appears to the examiner that the term IP in both specifications and claims is intended to mean "information provider" because the applicant provides this definition on page 2, lines 15-16 (" IP (Information Provider)". However, in the first instance of using the expression. Applicant then provides the proper definition on lines 15-16, followed by the acronym "IP" on line 18, then "information provider on lines 22-23, and so it goes in both the specifications and claims, switching back and forth. This inconsistency makes the reader unsure of the meaning of the acronym "IP", since the acronym "IP" is recognized in the art to mean "Internet Protocol" (Microsoft Computer Dictionary, Fifth Edition, Copyright (o) 2002 by Microsoft Corporation). The examiner requests that applicant 1) adopt the acronym "IP" the very first time the concept "information provider" is written in the specifications, and 2) that thereafter in both the specifications and claims the acronym "IP" is substituted for all expressions of "information provider". That is the convention adopted in the patent art

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a long time ago. Applicants are permitted to define their own terms as long as such definitions are consistently applied throughout the specifications and claims. Correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention due to a failure to clearly specify the invention's intent. The following claim elements are specifically unclear:

a. Confusion is created through the use of device language in each independent method claim (claims 1,4, 6 and 7) in the transition language to the detailed limitations: An example is claim 1, line 4, the phrase "wherein said transfer device comprises:". The examiner suggests substitute phrasing, such as "wherein said transfer device performs steps comprised of:". Correction is required.

b. The phrases "which are subject to IP billing" (example – Claim 1, line 6), "billing procedure with respect to the information provider/users" and other similarly ambiguous wording used throughout the claims represent an indefinite meaning of the intent. A grammatically correct version of this phrase would be "billing procedure to bill the IP (or user, etc.)" or "procedure to bill the IP". For the phrase "subject to IP billing" in Claim 1, lines 12-13, a grammatically correct expression would be "billable to the IP".

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The following phrases are the specific ambiguous and grammatically incorrect phrases in the context of the way the English language is understood in the United States of America:

Claim 1, lines 6-7, billing with respect to information providers

lines 10-11, subject to IP billing

lines 15-16, billing procedure with respect to the information provider

Claim 2: line 2, not to be subject to IP billing.

Claim 3: line 2, with respect to users

line 3, not to be subject to IP billing.

Claim 4: lines 5-6, whether or not to use IP billing

lines 9-10, is subject to IP billing

line 12-13, with respect to the information provider

Claim 5: line 2, with respect to users

line 2-3, not to be subject to IP billing

Claim 6: lines 5-6, subject to IP billing

line 6, with respect to the information provider

line 12-13, with respect to the information provider

Claim 7: line 6, subject to IP billing, ... billing with respect to the information provider

lines 7-8, that is not subject to IP billing

line 12, with respect to the user

Claim 8: lines 2-3, a communication fee with respect to communication services for the information transmission

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Claim 9: line 2, information fee with respect to information provided by

Claim 10, line 2, procedure of information fees with respect to users

lines 2-3, not being subject to IP-billing

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1-5 and 8-13** are rejected under 35 U.S.C. 102(e) as being anticipated by Sevcik (US Patent 6,266,699 filed April 17, 1997).

**Re. Claim 1**, Sevcik anticipates a billing method in a communication network including an information provider server device, a plurality of user terminals which receive information from said server device and a transfer device for routing information transmission between said server device and said user terminals (col. 1, Line 1 – Col.3, line 33; Col. 2, lines 14-22; Col. 3, lines 21-32); wherein said transfer device comprises:

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- a step of recording billing management information for identifying server devices which are to be subject to IP billing which is billing with respect to information providers (col. 3, lines 5-12);
- a step of detecting a network address of said server device designated when said user terminal receives an information transmission from said server device (Col. 2, lines 47-57; Col. 3, lines 5-9);
- a step of determining whether or not said server device is to be subject to IP billing based on the detected network address and said billing management information (Col. 2, lines 47-57; Col. 3, lines 5-12, lines 21-32; Col. 5, lines 22-26); and
- a step of performing a billing procedure with respect to the information provider which performed the information transmission if said server device is determined to be subject to IP billing (Col. 2, lines 47-57; Col. 5, lines 23-26).

**Re. Claim 2**, Sevcik anticipates a billing method as recited in claim 1, wherein said transfer device does not route an information transmission if it is determined not to be subject to IP billing (Col. 2, lines 32-43; Col. 2, line 62-Col. 3, line 9; Col. 4, lines 36-47).

**Re. Claim 3**, Sevcik anticipates a billing method as in claim 1, wherein said transfer device performs a billing procedure with respect to users who have received the information transmission if it is determined not to be subject to IP billing (Col. 2, line 62 – Col. 3, line 12).

**Re. Claim 4**, Sevcik anticipates a billing method in a communication network including an information provider server device, a plurality of user terminals which receive information from said server device and a transfer device for routing information transmission between said server device and said user terminals (col. 1, Line 1 – Col.3, line 33; Col. 2, lines 14-22; Col. 3, lines 21-32); wherein said server device comprises:

- a step of including billing information which indicates whether or not to use IP billing which is billing with respect to the information provider in the transmission data supplied to said user terminals in response to a request (Col. 2, lines 32-43, 47-57); and

said transfer device comprises:

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- a step of determining whether or not said information transmission is subject to IP billing based on said billing information when routing the exchange of said transmission data (Col. 2, lines 32-43, 47-57); and
- a step of performing a billing procedure with respect to the information provider which provided said information transmission if it is determined to be subject to IP billing (Col. 2, lines 47-57; Col. 5, lines 23-26).

**Re. Claim 5,** Sevcik anticipates a billing method as in claim 4, wherein said transfer device performs a billing procedure with respect to users who have received the information transmission if it is determined not to be subject to IP billing (Col. 2, lines 47-57; Col. 5, lines 23-2).

**Re. Claim 8,** Sevcik anticipates a billing method as in any one of claims 1-5, wherein the object of said billing is a communication fee with respect to communication services for the information transmission (Col. 2, Lines 49-57; col. 3, lines 17-20).

**Re. Claim 9,** Sevcik anticipates a billing method as in any one of claims 1-5, wherein the object of said billing is an information fee with respect to information provided by the information transmission (Col. 2, Lines 49-57; col. 3, lines 17-32).

**Re. Claim 10,** Sevcik anticipates a billing method as in claim 9, wherein said transfer device performs a billing procedure of information fees with respect to users if it is determined as not being subject to IP-billing, and otherwise does not perform a billing procedure of information fees (Col. 2, Lines 49-57; col. 3, lines 17-32; col. 5, lines 6-9).

**Re. Claim 11,** Sevcik anticipates a billing method as in any one of claims 1-5, characterized in that said server device belongs to a first communication network following a first communication protocol and said plurality of user terminals belong to a second communication network following a second communication protocol different from that of said first communication network; and said transfer device is a gateway for converting between said first and second communication protocols and routing information transmissions (Col. 2, Lines 49-57; col. 3, lines 17-32; col. 5, lines 6-9).

**Re. Claim 12,** Sevcik anticipates a billing method as in claim 11, wherein said second communication network is a local network accommodating specific user terminals; and said first information communication network is a global network interconnecting information resources such as said server device assigned identification information for identifying an absolute network address (Col. 2, line 62 – Col. 3, line 12; Col. 3, lines 17-32; col. 5, lines 6-9).



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**Re. Claim 13**, Sevcik anticipates a billing method as in claim 12, wherein said second communication network is a mobile communication network accommodating a plurality of user terminals which are mobile terminals, and said first information communication network is the Internet (Col. 3, lines 17-32).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 6-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sevcik in view of Schutzer (US Patent 6,292,789, filed Aug. 21, 1998) and Van Horne (US Patent 6,286,039, filed Apr. 8, 1998).

**Re. Claim 6**, Sevcik discloses a billing method in a communication network including an information provider server device, a plurality of user terminals which receive information from said server device and a transfer device for routing information transmission between said server device and said user terminals (col. 1, Line 1 – Col.3, line 33; Col. 2, lines 14-22; Col. 3, lines 21-32); wherein said transfer device comprises:

- information transmission that is subject to IP billing which is billing with respect to the information provider (Col. 3, lines 21-32), wherein said transfer device comprises:
  - a step of transmitting the information to user terminals which are the designated destinations; and
  - a step of performing a billing procedure with respect to the information provider which offered said information transmission.

Sevcik does not explicitly disclose a transfer device which comprises:

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a mailbox for mediating push-type information transmission that is subject to IP billing which is billing with respect to the information provider and comprises:

a step of storing in said mailbox information mail sent from said server device designating a desired destination and the address of said mailbox;  
a step of transmitting the information mail stored in said mailbox to user terminals which are the designated destinations; and  
a step of performing a billing procedure with respect to the information provider which offered said information transmission with respect to push-type transmission services through said mailbox.

- However, **Schutzer** teaches the use of electronic mail messages and electronic mailboxes for billing and storage of such messages in an electronic mailbox (Abstract, lines 9-13). Also, **Van Horne** discloses the use of push-type information transmission for billing options (Col. 16, lines 55-57). Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Sevcik by adopting the teachings of Schutzer and Van Horne for the purpose of efficiently operating an automated billing system.

**Re. Claim 7, Sevcik** discloses a billing method in a communication network including an information provider server device, a plurality of user terminals which receive information from said server device and a transfer device for routing information transmission between said server device and said user terminals; wherein said transfer device comprises:

- an information transmission that is subject to IP billing which is billing with respect to the information provider; and
- a user-billing information transmission that is not subject to IP billing.

Sevcik does not explicitly disclose a transfer device which comprises:

- an IP-billed mailbox for mediating push-type information transmission that is subject to IP billing which is billing with respect to the information provider; and

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- a user-billed mailbox for mediating information transmission that is not subject to IP billing; and
  - performing a billing procedure with respect to the information provider which offered said information transmission with respect to push-type information transmission services through said IP-billed mailbox; and
  - a step of performing a billing procedure with respect to the user that received said information transmission with respect to information transmission services through said user-billed mailbox.
- 
- However, **Schutzer** teaches the use of electronic mail messages and electronic mailboxes for transmitting billing information to and storage of such messages in an electronic mailbox (Abstract, lines 9-13). However, Schutzer does not disclose the use of push-type information transmission for billing options. However, **Van Horne** discloses the use of push-type information transmission for billing options (Col. 16, lines 55-57). Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Sevcik by adopting the teachings of Schutzer and Van Horne for the purpose of operating an efficient automated billing system.

**Re. Claim 8**, Sevcik discloses a billing method as in any one of claims 6-7, wherein the object of said billing is a communication fee with respect to communication services for the information transmission (Col. 2, Lines 49-57; col. 3, lines 17-20).

**Re. Claim 9**, Sevcik discloses a billing method as in any one of claims 6-7, wherein the object of said billing is an information fee with respect to information provided by the information transmission (Col. 2, Lines 49-57; col. 3, lines 17-32).

**Re. Claim 10**, Sevcik discloses a billing method as in claim 9, wherein said transfer device performs a billing procedure of information fees with respect to users if it is determined as not being subject to IP-billing, and otherwise does not perform a billing procedure of information fees (Col. 2, Lines 49-57; col. 3, lines 17-20; col. 5, lines 6-9).

**Re. Claim 11**, Sevcik discloses a billing method as in any one of claims 6-7, characterized in that said server device belongs to a first communication network following a first communication protocol and said plurality of user terminals belong to a

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second communication network following a second communication protocol different from that of said first communication network; and said transfer device is a gateway for converting between said first and second communication protocols and routing information transmissions (Col. 2, Lines 49-57; col. 3, lines 17-20; col. 5, lines 6-9).

**Re. Claim 12**, Sevcik discloses a billing method as in claim 11, wherein said second communication network is a local network accommodating specific user terminals; and said first information communication network is a global network interconnecting information resources such as said server device assigned identification information for identifying an absolute network address (Col. 2, line 62 – Col. 3, line 12; Col. 3, lines 17-20; col. 5, lines 6-9).

**Re. Claim 13**, Sevcik discloses a billing method as in claim 12, wherein said second communication network is a mobile communication network accommodating a plurality of user terminals which are mobile terminals, and said first information communication network is the Internet (Col. 3, lines 13-32).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Souh, can be reached on 703-308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks  
Washington D.C. 20231***

or faxed to:

**(703)305-7687** [Official communications; including  
After Final communications labeled  
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**(703) 746-8177** [Informal/Draft communications, labeled

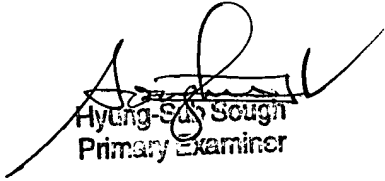
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"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.

SEC

Dec. 24, 2002



Hyung-Sun Soung  
Primary Examiner

## Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.